

REMARKS

Claims 1, 2, 4 and 7-23 are currently pending in the application. Claims 11-18, 20, and 21 were withdrawn from consideration by the Examiner as being directed to a non-elected invention. By this response, claim 1 is amended and claim 23 is added for the Examiner's consideration. Moreover, claim 3 is canceled without prejudice or disclaimer. The above amendments and new claim do not add new matter to the application and are fully supported by the original disclosure. For example, support for the amendments is provided in the claims as originally filed, at Figure 1, and at pages 1-3 of the specification. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

Withdrawn claims

The Examiner withdrew claims 11-18, 20, and 21 from consideration as being directed to a non-elected invention. The Examiner contends that independent claims 11, 16, and 20 do not include all of the technical features set forth in claim 1. More specifically, the Examiner asserts that claim 11 does not include that OSB boards are bonded together in multiple layers.

Applicants respectfully disagree. Claim 11 recites, amongst other things:

an outer layer of first oriented strand boards disposed side by side;
an inner layer of second oriented strand boards disposed side by side;
...
wherein the outer layer is connected to the inner layer, and

Contrary to the Examiner's opinion, claim 11 clearly and unambiguously recites oriented strand boards (OSB boards) bonded together in multiple layers. More specifically, claim 11 recites an outer layer of OSB boards and an inner layer of OSB boards, where the outer layer is connected to the inner layer. Applicants are confused as to how the Examiner is of the opinion that claim

11 does not include that OSB boards are bonded together in multiple layers, and request further clarification of this statement if the restriction requirement is maintained.

As independent claim 11 clearly contains the technical feature asserted by the Examiner to be lacking, Applicants respectfully request that at least claims 11-15 be rejoined and examined on the merits.

Completion of Record

Applicants submit in an attached Supplemental Information Disclosure Statement (IDS) a copy of DE 2606666, the abstract of which was cited by the Examiner in the outstanding Office Action. A machine-translation of the description of DE 2606666 is also included. The machine-translation is provided by <http://ep.espacenet.com/>, and Applicants make no representations or admissions as to its accuracy or the information contained therein. Applicants request consideration of this entire reference by having an initialed and signed copy of the PTO-1449 returned to the undersigned.

35 U.S.C. §103 Rejection

Claims 1, 2, 4, 7-10, 19, and 22 are rejected under 35 U.S.C. §103(a) for being unpatentable over U.S. Patent No. 5,098,762 issued to Nakajima (“Nakajima”) in view of U.S. Patent No. 6,696,167 issued to Sean *et al.* (“Sean”). Claim 2 is rejected under 35 U.S.C. §103(a) for being unpatentable over Nakajima in view of Sean, and further in view of DT 2606666 or U.S. Patent No. 6,625,943 issued to Renner (“Renner”). These rejections are respectfully traversed.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations (See MPEP §2142). Applicants submit that no proper combination of the applied references teaches or suggests all of the features of the claimed invention.

Claims 1, 2, 4, 7-10, 19, and 22 in view of Nakajima and Sean

As previously discussed, such that further elaboration is not believed necessary, the present invention relates to a building board for use as a ceiling or wall element. Independent claim 1 has been amended to include the features of claim 3, and now recites:

... a plurality of orientated strand boards (OSBs) which are disposed side by side and are bonded together in multiple layers, further comprising some interspaces filled with an insulating material and other interspaces devoid of the insulating material, and at least one nail plate disposed between respectively two layers lying one on top of the other.

Applicants respectfully submit the applied references (i.e., Nakajima and Sean) do not disclose or suggest this combination of features. More particularly, the applied references do not disclose or suggest at least one nail plate disposed between respectively two layers lying one on top of the other. The Examiner impliedly acknowledges that the combination of Nakajima and Sean does not disclose at least one nail plate disposed between respectively two layers lying one on top of the other, since claim 3 was not rejected in view of Nakajima and Sean in the outstanding Office Action.

In any event, Applicants submit that neither Nakajima nor Sean discloses a nail plate. For example, Applicants acknowledge that Nakajima shows multiple boards bonded together to form layers; however, Nakajima only discloses that the layers are adhered together (column 2, line 1). Sean does not disclose a plurality of boards bonded together in layers, and consequently does not disclose any structure for bonding layers together. Therefore, neither Nakajima nor Sean discloses or suggests at least one nail plate disposed between respectively two layers lying one on top of the other, as recited in claim 1.

Claims 2, 4, 7-10, 19, and 22 depend from allowable independent claim 1, and are allowable at least for the reasons discussed above with respect to claim 1. Moreover, Applicants submit the applied art does not show the combinations of features further recited in these dependent claims.

Accordingly, Applicants respectfully request that the §103(a) rejection over claims 1, 2, 4, 7-10, 19, and 22 be withdrawn.

Claim 2 in view of Nakajima and Sean, and further in view of DT 2606666 or Renner

Applicants note that paragraph 4 of page 3 of the outstanding Office Action states that claim 2 is rejected in view of Nakajima and Sean, and further in view of DT 2606666 or Renner. However, the explanation of this rejection discusses a nail plate, which is not recited in claim 2, but, instead, was recited in claim 3 at the time the rejection was made. Therefore, the record is unclear as to whether claim 2 or claim 3 is rejected in view of Nakajima and Sean, and further in view of DT 2606666 or Renner.

If the rejection is of claim 3, then Applicants note that claim 3 is canceled by this response, such the rejection of claim 3 is now moot. In any event, Applicants submit that none

of the applied references discloses or suggests at least one nail plate disposed between respectively two layers lying one on top of the other, as now recited in claim 1.

Renner discloses a building system in which a nail plate 75 spans a gap between two boards arranged end-to-end (e.g., a butt joint) (see, e.g., FIG. 3). This differs from the present invention, in which a nail plate is disposed between two layers of boards lying one on top of the other. That is, in Applicants' invention, the nail plate is sandwiched between two layers. Renner does not disclose or suggest that a nail plate can be arranged between two layers.

Similar to Renner, DE 2606666¹ discloses a nail plate used for fixing a butt joint in which two boards are attached end-to-end (see, e.g., FIGS. 15-19). Again, this differs from the present invention, in which a nail plate is disposed between two layers of boards lying one on top of the other. DE 260666 does not disclose or suggest that a nail plate can be arranged between two layers.

Accordingly, Applicants respectfully request that the §103(a) rejection over claim 2 (and 3) be withdrawn.

Added Claim

By this response, claim 23 is added for the Examiner's consideration. Applicants submit that claim 23 depends indirectly from allowable claim 1, and is allowable for the reasons discussed above with respect to claim 1. Moreover, claim 23 additionally recites at least one plastic mat structured and arranged to increase the sound-insulation and heat insulation of the building board, wherein the at least one plastic mat is disposed between the outermost layer and the second layer, and the at least one nail plate is disposed between the second layer and a third

¹ Applicants assume that the Examiner is referring to DE 2606666, a copy of which is attached to the outstanding Office Action.

layer of the plurality of orientated strand boards. This combination of features is not suggested by the applied art. For example, the Examiner has not identified any reference that discloses a building board comprising at least one plastic mat structured and arranged to increase the sound-insulation and heat insulation of the building board. Also, as discussed above, none of the references suggests a nail plate disposed between layers of the building board.

Other Matters

Applicants note that Office Action Summary indicates claim 3 as being rejected; however, the Detailed Action does not identify and set forth a rejection of claim 3. Although Applicants presume the Examiner is addressing the features of claim 3 in paragraph 4 of page 3 of the Office Action, the record is not clear on this issue.

Moreover, the Examiner repeatedly refers to a prior art reference as “DT 2606666.” However, there is no such reference. Although Applicants presume the Examiner is referring to DE 2606666, the record is not clear on this issue.

For these reasons, Applicants submit that a clear issue was not developed between the Examiner and Applicants. As such, Applicants submit that the next Office Action should clarify this issue and cannot properly be made final.

According to MPEP 706,

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection.

Accordingly, Applicants respectfully request clarification of these issues in the next Office Action. Moreover, as these issues have not yet been clearly developed by the Examiner, Applicants respectfully submit that the next Office Action cannot properly be made final.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 19-0089.

Respectfully submitted,
Joachim HASCH et al.

A handwritten signature in black ink, appearing to read 'Andrew M. Calderon', written over a horizontal line.

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October 22, 2007
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